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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,692	02/04/2004	Bruce C. Polzin	080643-0111	5118

7590 12/14/2005
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EXAMINER

KYLE, MICHAEL J

ART UNIT PAPER NUMBER

3677

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/772,692

Applicant(s)

POLZIN ET AL.

Examiner

Michael J. Kyle

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 is/are pending in the application.
- 4a) Of the above claim(s) 12-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/4/04, 12/17/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 12-63 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Groups II-V, there being no allowable generic or linking claim.

Applicant timely traversed the restriction (election) requirement in the reply filed on September 21, 2005. Examiner notes that the product as claimed could be made by fastening the layers with adhesive.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9/21/12/14/05
1,3-11
3. Claims ~~1-11~~ are rejected under 35 U.S.C. 103(a) as being unpatentable over Rechelbacher (U.S. Patent No. 6,647,582) in view of Kendall (U.S. Patent No. 5,775,233). With respect to claims 1 and 2, Rechelbacher discloses a cushioning and vibration dampening apparatus comprising an overmold (30). The overmold is a mixture of an elastomeric material (38, 46) and a gel or putty like substance (32). The overmold comprises first (46) and second (38) non-foam layers enveloping a gel or putty like layer. Rechelbacher discloses the elastomeric material to be rubber or plastic. Examiner considers this to be thermoplastic rubber. Rechelbacher discloses the layer enveloped by the non-foam layers to be a gel or putty like material, but does not specifically disclose foam.

Art Unit: 3677

4. Kendall teaches a handle grip (11) comprising either gel or foam, or equivalents thereof (column 4, lines 4, 5). Thus, Kendall shows gel and foam to be equivalent as either may be used to accomplish the same function. Foam includes micro-cellular foams. It would have been obvious to one having ordinary skill in the art at the time of the invention to make the middle layer from either gel or foam, as they are equivalent within the art.

5. Claim 3 recites method limitations (“integrally molded” and “injection molding”) in an article or apparatus claim. This method limitation is given little patentable weight.

Rechelbacher and Kendall’s non-foam layers and the foam layer can be integrally molded with each other. Examiner notes that in a product-by-process claim such as these claims, the prior art must only be capable of being made by the claimed process, as long the as the final product meets the structural limitations of the claim. See MPEP 2113.

6. With respect to claim 4, Rechelbacher discloses a substrate member (18) coupled to the overmold member (30).

7. With respect to claims 5 and 6, the combination of Rechelbacher and Kendall disclose the non-foam layers and foam layer can be mechanically attached (via 42 and 44 of Rechelbacher) or bonded to the substrate member. Examiner considers the grip of Rechelbacher to be bonded to the substrate because it is fixedly attached to the substrate.

8. With respect to claim 7, Rechelbacher discloses the substrate member to be wood.

9. With respect to claims 8 and 10, the combination of Rechelbacher and Kendall fails to disclose the thickness of the foam layer to exceed the combined thickness of the non-foam layers, or for the thickness to be equal. However, such a modification does not appear to bring about a new or unexpected result. One having ordinary skill in the art would recognize that

Art Unit: 3677

changing the relative thickness of the foam and non-foam layers on a known structure will affect the flexibility of the overmold member, but will still provide the cushioning and vibration dampening functions. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the combination of Rechelbacher and Kendall such that the thickness of the foam layer is equal to or exceeds the combined thickness of the non-foam layers, as such a modification does not produce a new or unexpected result.

10. With respect to claim 9, the combination of Rechelbacher and Kendall discloses the thickness of the non-foam layer to exceed the thickness of the foam layer (figure 5 of Rechelbacher).

11. With respect to claim 11, Rechelbacher discloses the overmold to be configured in a predetermined shape.

12. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rechelbacher in view of Kendall as applied to claim 1 above, and further in view of Watarai (U.S. Patent No. 5,848,555). Rechelbacher discloses the elastomeric material to be rubber or plastic. While examiner considers the rubber of Rachelbacher to be a thermoplastic rubber as claimed, examiner further relies on the teachings of Watarai to further show equivalents between rubber and the claimed materials.

13. Watarai teaches a grip portion (4) made from rubber or polyvinyl chloride ("PVC", column 1, line 66). Thus, these two materials are equivalent and interchangeable within the art, as either material may be used to accomplish the same function. It would have been obvious to

Art Unit: 3677

one having ordinary skill in the art at the time of the invention to make the elastomeric material of either rubber or PVC, as these materials are equivalent in the art.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references are cited to further show the state of the art with respect to handle cushioning devices: Dellis, Sexton, McCall, Brown, Wildforster, Hildenbrandt, Bendick, Huybrechts, Scatterday, Gwinn, Ferrara, Jr., Watarai, and DeLuca et al.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Kyle whose telephone number is 571-272-7057. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 571-272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mk


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